

### **Remarks**

The present application claims priority on U.S. Patent No. 6,488,427 and Serial number 09/515,956. The disclosures of these applications are incorporated by reference. The U.S. application Serial No. 09/515,956, is a parent of this application describes the driving member as follows: "a disk capable of traveling through the camber forcing the product through said orifice as it travels said chamber, said disk having a generally flat product contact surface that contacts a major portion of said top surface when the travel of the disk is complete so that the product remaining in said chamber is minimized."

### ***Drawings***

Examiner has objected to the drawings under 37 CFR 1.83(a) as not sufficiently showing every feature of the invention specified in the claims. Examiner has averted that there is new matter in claims 31, 32, 43. Applicant has amended these claims to only claim subject matter which is clearly disclosed in the drawings.

### ***Specification***

The Examiner has objected to the specification for failing to provide proper antecedent basis for the claimed subject matter in claims 31, 32, 43. Applicant has amended claims 31, 32, 43 to remove the objected to language and replace it with subject matter disclosed in the specification.

***Claim Rejections***

**35 U.S.C. §112**

The Examiner has rejected claims 31,32, 43 and 49-52 under 35 U.S.C. §112, as claiming new matter that was not described in the specification. Applicant has amended the claims to claim matter which has been disclosed in the Specification and by the drawings. Figure 2 by shows that the contact surface of the driving member is generally the same angle as the tip of applicant's applicator. Applicant has also disclosed this feature of the invention in the specification on page 12 lines 15-16, "...in one embodiment the driving member may be angled 28. Where the driving member is angled, the underside of the tip 32 should also be angled to permit the user to remove as much product as possible from the applicator. "

***Double Patenting***

The Examiner has rejected claim 45 on the ground of nonstatutory obviousness type double patenting as being unpatentable over claim 26 of USPN 6607323. In addition, the Examiner has also rejected claims 15, 17-19, 31-35 and 44 on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 22-24 of USPN 6607323 in view of USPN 5879095 (Gueret). Attached hereto, is a terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321(d), which may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with the application, or claims an invention made as a result of

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activities undertaken within the scope of a joint research agreement.

Since the patent US Patent No. 6607323 is commonly owned by Cosmetic Concepts, the terminal disclaimer should now render the Examiners rejections moot.

### **35 USC §102**

The Examiner has rejected claims 15, 17-19, 31-35, 43, 49 and 52 under 35 U.S.C. 102 as being anticipated by Gaebel. Applicant has amended, independent claims 31, 32, 43, 46 and 47, to further distinguish the present invention than the above cited prior art. In particular, regarding claims 31, 32 43, 46 and 47 applicant has further limited the claims to further distinguish the present invention from the above cited prior art. In particular to include "...said product contact surface being flat and capable of traveling through the reservoir forcing product through orifice as it travels through said reservoir said product contact surface contacting a major portion of the inner surface of said tip when the travel of the disk is complete so that product remaining said chamber is minimized ... The Gaebel disclosure does not teach or suggest of such a configuration. The Gaebel patent does include a driving member which forces a pasty substance through the reservoir in, but it does not minimize the amount of product which is left in the reservoir. This is because the driving member only forces the paste through an opening and into another section of the reservoir; and the driving member does not contact the inner surface of the tip where the product is dispensed through. There is no means to drive the paste through the second section of the reservoir. As a result once the driving member has reached the end of the reservoir there is no way for

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the user to minimize the amount of paste remaining in the reservoir. In Applicant's invention the amount of product minimized since the driving member is at the same general angle with the base as the contact surface of the reservoir. The driving member contact surface is able to push the product through an orifice into a slightly concave tip for application. This then leaves minimal amounts of product remaining in the reservoir once the driving member has reached the contact surface of the reservoir.

### **35 USC § 103**

The following are obviousness rejections were averred by the Examiner:

The Examiner has rejected to claims 44, 46 and 47, under 35 U.S.C. 103(a) as being unpatentable over Gaebel USPN (4622984). Applicant has amended, independent claims 46, and 47 to further distinguish the present invention from the above cited prior art. In particular, applicant has further limited the driving member in these claims so as to include that the color of the product in the reservoir may be viewed through the side of the tip. The Gueret disclosure does not teach or suggest of such a configuration, as such claims 46 & 47 and any claims depending therefrom should be in a condition for allowance.

Examiner has rejected claims 32 and 36 as unpatentable over Gueret, applicant respectfully traverses. The Gueret patent does not disclose a means for minimizing the amount of product which remains in the applicator. The driving member in Gueret does not fit flush up against the end the Gueret reservoir. Although the neck of the driving

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member does fit into the opening in the reservoir, the sides do not fit flush up against the sides of the reservoir. The two walls are not at the same angle. This will cause product to be left between the driving member and the reservoir.

In addition, the applicant has amended, independent claims 44 and 45 to further distinguish the present invention from the above cited prior art. In particular, applicant has further limited these claims so as to include "wherein a user can view the color of the product in said reservoir through side of said tip." Neither Gueret, Lang nor Kapustin, alone or any combination thereof, teach or suggest of such a configuration, as such claims 44 and 45 and any claims depending therefrom should be in a condition for allowance.

### **CONCLUSION**

For the foregoing reasons, applicant's claims are patentable over the cited prior art and the application should be in condition for allowance.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that the foregoing Response was mailed by first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 on this 32<sup>nd</sup> day of, May, 2007.



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